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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,066	11/09/2001	Tomohiro Ohzuru	5404-11	3858

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EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,066

Applicant(s)

OHZURU ET AL.

Examiner

Adrienne C. Johnstone

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-7 and 9-69 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, drawn to a multilayered endless belt, classified in class 428, subclass 174.
 - II. Claims 6, 7, and 9-13, drawn to a method of making a multilayered endless belt from films of specified composition, classified in class 156, subclass 184.
 - III. Claims 14-28 and 40-69, drawn to a method of making a medium conveying belt having an electrically conductive electrode pattern, classified in class 29, subclass 592.1.
 - IV. Claims 29-35, 37, and 38, drawn to an endless belt molding apparatus, classified in class 156, subclass 583.3.
 - V. Claims 36 and 39, drawn to a method of molding an endless belt, classified in class 156, subclass 286.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II-III-V and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one in which the layers are not heat-bonded (bonded by solvent, radiation, etc.).
3. Inventions IV and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as

Art Unit 1733

claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as one with an expandable axial core acting against a female mold to press the layers together.

4. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all of the limitations of the subcombination are not required in the combination. The subcombination has separate utility such as a method of making a multi-layered endless drive belt or press belt.

5. Inventions II-III-V and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one in which the article molded is not an endless belt (tube, hose, etc.).

6. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention V has separate utility such as a method of molding an endless belt without the nonthermoplastic polyimide film layer required in Invention II. See MPEP § 806.05(d).

Art Unit 1733

7. Inventions III and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because all of the limitations of the subcombination are not required in the combination. The subcombination has separate utility such as a method of molding an endless drive belt or press belt.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

9. If Invention I is elected, a further election of species is required as set forth below.

10. This application contains claims directed to the following patentably distinct species of the claimed invention: a multilayered endless belt wherein either 1) the nonthermoplastic polyimide film is adjacent to an adhesive layer and a smooth winding starting end is formed (one adhesive layer inside the nonthermoplastic polyimide film) or 2) the nonthermoplastic polyimide film is adjacent to an adhesive layer and a smooth winding finishing end is formed (one adhesive layer outside the nonthermoplastic polyimide film) or 3) the nonthermoplastic polyimide film is adjacent to an adhesive layer and both smooth ends are formed (two adhesive layers one on either side of the nonthermoplastic polyimide film layer or 4) the nonthermoplastic polyimide film is adjacent to a thermoplastic resin layer and a smooth winding starting end is formed (one thermoplastic resin layer inside the nonthermoplastic polyimide film) or 5) the nonthermoplastic polyimide film is adjacent to a thermoplastic resin layer and a smooth winding finishing end is formed (one thermoplastic resin layer outside the nonthermoplastic polyimide film) or 6) the

Art Unit 1733

nonthermoplastic polyimide film is adjacent to a thermoplastic resin layer and both smooth ends are formed (two thermoplastic resin layers one on either side of the nonthermoplastic polyimide film layer)(specification p. 45 line 12 - p. 47 line 10).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic to species 1-3 and claim 2 is generic to species 4-6.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. If Invention II is elected, a further election of species is required as set forth below.
12. This application contains claims directed to the following patentably distinct species of the claimed invention: a method of making a multilayered endless belt wherein either 1) the

Art Unit 1733

nonthermoplastic polyimide film layer is laminated to an adhesive layer to form a laminate film before winding around the axial core or 2) the nonthermoplastic polyimide film layer is laminated to a thermoplastic resin layer to form a laminate film before winding around the axial core or 3) the nonthermoplastic polyimide film and a thermoplastic resin film are delivered and simultaneously wound around the axial core (specification p. 38 lines 19-24).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. If Invention III is elected, further elections of species are required as set forth below.

Art Unit 1733

14. Claims 14-19, 40-45, and 55-60 are generic to a plurality of disclosed patentably distinct species comprising a method of making a medium conveying belt having an electrically conductive electrode pattern wherein the film prepared in the film preparing step is either 1) a thermoplastic film or 2) a laminate film prepared as in claim 6 for claims 14-19 or 3) a laminate film prepared as in claim 7 for claims 40-45 or 4) a laminate film prepared as in claim 9 for claims 55-60 (specification p. 53 line 3 - p. 54 line 8). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

15. This application contains claims directed to the following patentably distinct species of the claimed invention: a method of making a medium conveying belt having an electrically conductive electrode pattern wherein either 1) the electrically conductive electrode pattern is formed on an outer circumferential surface of a multilayered endless belt by forming the electrode pattern on one surface of one end of the outer surface of the outer film of the laminate film or the thermoplastic film, and a separate electrode protective layer covers the electrode pattern on the outer circumferential surface of the belt or 2) the electrically conductive electrode pattern is formed on an outer circumferential surface and an inner circumferential surface of a multilayered endless belt by forming the electrode pattern on one surface of one end and the opposite surface of the opposite end of the outer surface of the outer film of the laminate film or the thermoplastic film, allowing electric power supply from the inner electrode pattern, and a separate electrode protective layer covers the electrode pattern on the outer circumferential

Art Unit 1733

surface of the belt or 3) the electrically conductive electrode pattern is formed on an outer circumferential surface of a multilayered endless belt by forming the electrode pattern on one surface of a portion around the center of the outer surface of the outer film of the laminate film or the thermoplastic film, so that the outer end portion forms the electrode protective layer or 4) the electrically conductive electrode pattern is formed on an outer circumferential surface of a multilayered endless belt by forming the electrode pattern on one surface of a portion around the center and on the opposite surface of the inner end of the outer surface of the outer film of the laminate film or the thermoplastic film, allowing electric power supply from the inner electrode pattern, so that the outer end portion forms the electrode protective layer or 5) the electrically conductive electrode pattern is formed on an outer circumferential surface of a multilayered endless belt by forming the electrode pattern on the inner surface of the electrode protective film or 6) the electrically conductive electrode pattern is formed on an outer circumferential surface of a multilayered endless belt by forming the electrode pattern on one surface of one end of the outer surface of the outer film of the laminate film or the thermoplastic film, and a separate electrode protective layer having a smaller width than the belt covers the electrode pattern on the outer circumferential surface of the belt so that after winding and heating the protruding width of the belt including the electrode pattern is bent inward and press-bonded by heating to allow electric power supply from the inside or 7) species 1 is modified to allow electric power supply from the inside by establishing electrical conduction between the electrode pattern and the inside surface of the belt (not a Markush group because every possible alternative for establishing the electrical conduction is included) or 8) species 3 is modified to allow electric power supply from the inside by establishing electrical conduction between the electrode pattern and the inside surface of the belt (not a Markush group because every possible alternative for establishing the electrical conduction is included) or 9) species 5 is modified to allow electric power supply from

Art Unit 1733

the inside by establishing electrical conduction between the electrode pattern and the inside surface of the belt (not a Markush group because every possible alternative for establishing the electrical conduction is included)(specification p. 53 line 3 - p. 54 line 8, p. 74 line 15 - p. 77 line 15, p. 82 line 21 - p. 91 line 11).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

16. If Invention IV or Invention V is elected, further elections of species are required as set forth below.

Art Unit 1733

17. This application contains claims directed to the following patentably distinct species of the claimed invention: an endless belt molding apparatus according to the embodiment of either 1) Figure 46 (specification p. 98 line 8 - p. 100 line 9 and p. 112 line 14 - p. 119 line 9) or 2) Figure 47 (specification p. 100 line 10 - p. 102 line 8 and p. 112 line 14 - p. 119 line 9) or 3) Figure 48 (specification p. 102 line 9 - p. 119 line 10 and p. 112 line 14 - p. 119 line 9) or 4) Figure 59 (specification p. 119 line 11 - p. 128 last line).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 29 is generic in Invention IV and no claim is generic in Invention V.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit 1733

18. Claim 32 is generic to a plurality of disclosed patentably distinct species comprising an endless belt molding apparatus wherein the endless tube is either thin metal or heat-resistant resin. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

19. Claim 36 is generic to a plurality of disclosed patentably distinct species comprising an endless belt molding method wherein the wound films are attached either while maintaining the space b in a reduced-pressure state or before reducing the pressure in spaces a and b. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

20. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

Art Unit 1733

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059.

The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

A handwritten signature in black ink, appearing to read "Adrienne C. Johnstone", written in a cursive style.

Adrienne Johnstone

September 15, 2003